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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ANDRE B. BLACK, DAVID F. CHEUNG,  
RUBY KENNEDY, YUCHUN LEE, and  
PATRICK MARTIN

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Appeal 2016-004794  
Application 11/492,012<sup>1</sup>  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, HUBERT C. LORIN and  
TARA L. HUTCHINGS, Administrative Patent Judges.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Andre B. Black, et al. (Appellants) seek our review under 35 U.S.C. § 134(a) of the Final Rejection of claims 1–31. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

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<sup>1</sup> The Appellants identify IBM Corporation as the real party in interest. App. Br. 1.

### THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A computer-implemented method for promotion management comprising:
  - receiving, by one or more computers, a promotion template, having a promotion code format specifying:
    - an immutable field portion; and
    - a mutable field portion to be populated with information uniquely identifying a promotion instance that is generated from the promotion template;
  - producing, by the one or more computers, the promotion instance from the promotion template; and
  - generating, based on the promotion code format, a promotion code for the promotion instance by:
    - populating by the one or more computers the mutable field portion with information uniquely identifying the promotion instance.

### THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Bibelnieks	US 2003/0208402 A1	Nov. 6, 2003
Liu	US 2005/0075926 A1	Apr. 7, 2005

The following rejections are before us for review:

1. Claims 1–31 are rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

2. Claims 1, 3–11, 13–16, 18–26 and 28–31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Liu.
3. Claims 2, 12, 17 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Liu and Bibelnieks.

### ISSUES

Did the Examiner err in rejecting claims 1–31 under 35 U.S.C. §101 as being directed to non-statutory subject matter?

Did the Examiner err in rejecting claims 1, 3–11, 13–6, 18–26 and 28–31 under 35 U.S.C. §102(b) as being anticipated by Liu?

Did the Examiner err in rejecting claims 2, 12, 17 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Liu and Bibelnieks?

### ANALYSIS

*The rejection of claims 1-31 under 35 U.S.C. §101 as being directed to non-statutory subject matter.*

The Appellants argued these claims as a group. *See* Reply Br. 3-8. We select claim 1 as the representative claim for this group, and the remaining claims 2–31 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

*Alice Corp. Proprietary Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent-eligibility under 35 U.S.C. § 101.

According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

In that regard, the Examiner determined that “the claims are directed towards the concept of [serving advertisements in a virtual world]. [serving online advertisements is considered a fundamental economic practice and is simply a series of mathematical formulations in a computer application installed on a generically recited processor], therefore the claims are drawn to an abstract idea.” Final Rej. 2–3.

The Appellants contend that “the Examiner mischaracterized the invention to which the claims are directed.” App. Br. 12. However, the Appellants do not clearly explain what the claims *are* directed to.

In the Brief, the Appellants argue that “the claims involve the creation of a web page and/or website, which is necessarily performed with a computer.” App. Br. 13. But as the Appellants themselves later concede “the claims [do] not recite ‘a website.’” Reply Br. 2.

In the Reply Brief, the Appellants argue that

[w]hile the Examiner asserts that “[t]he claims as a whole disclose only the abstract idea of providing advertising in promotions,” the claims do not even recite “providing advertising in promotions.” Instead, the claims are directed to generating a promotion instance a promotion and to generating a promotion code for the promotion instance. Thus, the Examiner has not accurately characterized the claimed invention, as a whole. Both the promotion code and promotion template are unnecessary for “providing advertising,” and thus, these aspects of the claimed invention are substantially more than the alleged abstract idea.

Reply Br. 4.

It is true that claim 1 does not recite “providing *advertising in promotions*.” Rather, it is more broadly “promotion *management*” — as recited in the preamble. *Two-Way Media Ltd. v. Comcast Cable Communications, LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017) (“we see no error here in the district court citing to the preamble in its review of whether the claims are directed to an abstract idea.”)

“The ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas v. DirectTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (*quoting Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); see also *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016), quoted in *Apple, Inc. v. Ameranth, Inc.*, 7842 F.3d 1229, 1241 (Fed. Cir. 2016).

In that regard, the Background section of the Specification discusses the problem, which the Specification describes as “challenges in managing promotions [that] can arise out of the various situations in which promotions are used.” 1:3–4. The inventors appear to solve the problem by providing for *techniques* for promotion management having various “aspects.” One of those aspects, relevant to what is claimed, comprises “producing a promotion instance from a promotion template [and] setting one or more attribute fields of the promotion instance.” 1:13–14.

In light of Specification’s description of the problem and solution, the advance over the prior art by the claimed invention is, generally-speaking, managing promotions. In more specific terms, one of the advances the

Specification describes that is relevant to what is claimed lies in a technique whereby a promotion instance is produced from a promotion template and one or more attribute fields of the promotion instance are set. This is the heart of the invention as claimed and, as such, claim 1 is properly characterized as being directed to that. *Cf. Intellectual Ventures I LLC v. Erie Indemnity Company*, 850 F.3d 1315, 1328 (Fed. Cir. 2017)(“the heart of the claimed invention lies in creating and using an index to search for and retrieve data ... an abstract concept.”)

In any case, whether the concept to which claim 1 is directed to is characterized generally as a technique for managing promotions or specifically as a technique for managing promotions whereby a promotion instance is produced from a promotion template and one or more attribute fields of the promotion instance are set, in either case, the concept is an abstract idea, differing only in their level of abstraction, the latter being the less abstract one.

The Appellants argue, alternatively, that “the claims are directed to generating a promotion instance a promotion [sic] *and to generating a promotion code for the promotion instance.*” Reply Br. 4 (emphasis added). But even if we were to accept this alternative wording of the concept to which claim 1 is directed to, the thusly-worded concept is still an abstract one. Its character is no less abstract than the concepts articulated above.

The Appellants challenge the Examiner’s determination that the concept to which claim 1 is directed to — as the Examiner characterized it — is an abstract idea. (Presumably, the concepts we have laid out above, as well as the one the Appellants have articulated, are subject to the same

challenge.) According to the Appellants, the concept is not a fundamental economic practice (App. Br. 14–15), idea of itself (App. Br. 15) or mathematic relationships/formulas (App. Br. 15–16).

“However, a search for a single test or definition in the decided cases concerning § 101 from this court, and indeed from the Supreme Court, reveals that at present there is no such single, succinct, usable definition or test. ... instead of a definition, then, the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.” *Amdocs (Israel) Limited v. Openet Telecom, Inc.* 841 F.3d 1288, 1294 (Fed. Cir. 2016), *cert. denied*, *Openet Telecom, Inc. v. Amdocs (Israel) Ltd.*, 138 S. Ct. 469, 470 (U.S. 2017). In that regard, we see little difference between the various concepts claim 1 is said to be directed to and the “method of 1) extracting data from hard copy documents using an automated digitizing unit such as a scanner, 2) recognizing specific information from the extracted data, and 3) storing that information in a memory” involving the use of templates that was at issue in *Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass'n*, 776 F.3d 1343, 1345 (Fed. Cir. 2014), *cert denied*, 136 S. Ct. 119 (2015) (*cf. e.g.*, claim 1 of US 5,768,416).

For the foregoing reasons, we are unpersuaded that the Examiner’s step one determination was in error.

Step two is “a search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible

concept] itself.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 73 (2012)).

In that regard, the Examiner determined that

[t]he claims do not recite limitations that are "significantly more" than the abstract idea because the claims do not recite an improvement to another technology or technical field, an improvement to the functioning of the computer itself, or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment. [It should be noted the limitations of the current claims are performed by the generically recited processor]. The limitations are merely instructions to implement the abstract idea on a computer and require no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry.

Final Rej. 3.

The Appellants do not challenge the Examiner’s determination under step two.

We have considered all of the Appellants’ remaining arguments and have found them unpersuasive. Accordingly, because representative claim 1 and claims 2-31, which stand or fall with claim 1, are directed to an abstract idea and there is no dispute over whether they otherwise present an “inventive concept,” we sustain the Examiner’s determination that they are directed to ineligible subject matter under 35 U.S.C. § 101. *Cf.* *LendingTree, LLC v. Zillow, Inc.*, 656 F. App’x 991, 997 (Fed. Cir. 2016) (“We have considered all of LendingTree’s remaining arguments and have found them unpersuasive. Accordingly, because the asserted claims of the patents in suit are directed to an abstract idea and do not present an ‘inventive concept,’ we hold that they are directed to ineligible subject matter under 35 U.S.C. § 101.”).

The rejection is sustained.

*The rejection of claims 1, 3–11, 13–16, 18–26 and 28–31 under 35 U.S.C. §102(b) as being anticipated by Liu.*

The issue is whether Liu describes, expressly or inherently, a “promotion code” “generat[ed], based on [a] promotion code format.” Claim 1. The same limitation appears in the other independent claims 16 and 31.

The Examiner relies on “(figure 6a and para 97-101, example given as offer tracking code)” (Final Rej. 4) as evidence that said promotion code is described in Liu.

We have reviewed said disclosure. All we could find there is “Offer Tracking Code-A unique number to identify the promotion.” Para. 100. We do not see there any discussion about a “promotion code” “generat[ed], based on [a] promotion code format” as that phrase is used in the claims.

Accordingly, the rejection is not sustained because a preponderance of the evidence does not support the finding that the independent claims read on Liu.

*The rejection of claims 2, 12, 17 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Liu and Bibelnieks.*

This rejection relies on the finding that Liu describes, expressly or inherently, a “promotion code” “generat[ed], based on [a] promotion code format” as claimed. Because that finding is not supported by a preponderance of the evidence, a prima facie case of obviousness for dependent claims 2, 12, 17 and 27 has not been made out in the first instance.

### CONCLUSIONS

The rejection of claims 1–31 under 35 U.S.C. §101 as being directed to non-statutory subject matter is affirmed.

The rejection of claims 1, 3–11, 13–16, 18–26 and 28–31 under 35 U.S.C. §102(b) as being anticipated by Liu is reversed.

The rejection of claims 2, 12, 17 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Liu and Bibelniaks is reversed.

### DECISION

The decision of the Examiner to reject claims 1–31 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED